



PATENT
Attorney Docket 046124-5025

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In re Application of: **Yukio KATO et al.**)
)
Application No. **09/555,342**)
)
Filed: **May 26, 2000**)
)
For: **Human Fetus Chondrocyte-Derived Gene**)

Group Art Unit: **1642 TECH CENTER 1600/2900**

Examiner: **Minh-Tam Davis**

Commissioner for Patents
Washington, D.C. 20231

REPLY TO OFFICE ACTION (RESTRICTION REQUIREMENT)

This Reply is responsive to the Office Action (Paper No. 12) dated July 2, 2002, the time period for response to which expired August 2, 2002. An extension of time for two months is being filed concurrently, thereby extending the period for response to October 2, 2002.

In the Office Action dated July 2, 2002, the Examiner requires an additional restriction between the newly submitted claims 33-38, with the elected species to be examined along with the pending claims 15-17, 25-28 and 32. In response, Applicants elect claim 34, Group 2, directed to an isolated nucleic acid molecule obtained by amplification using primers having the sequences of SEQ ID NO: 21 and SEQ ID NO: 22.

Applicants note that no generic claims have been identified in the Office Action pursuant to MPEP §809.02(a). Accordingly, it is Applicants' understanding that all of the previously pending claims (claims 15-17, 25-28 and 32) will be examined in addition to elected claim 34. This would be appropriate given that elected claim 34 is generic

with respect to the previously pending claims to the extent that the primers recited in claim 34 amplify CDEP cDNAs (see page 30, lines 1-7 of the specification), and the sequences recited in claims 15-17, 25-28 and 32 read on or recite the specific CDEP cDNA sequences disclosed in the specification (see page 8, line 25 and page 9, lines 11-13). Thus, in partial response to the election requirement, the claims that are readable on the elected species are all of the previously pending claims (claims 15-17, 25-28 and 32).

The restriction requirement is traversed because it would not constitute an undue burden to perform a database search on all the claimed primer combinations. The claimed primer combinations may each be used to amplify CDEP DNA and cDNA sequences (see page 23, lines 15-19), and it would be unreasonable to require Applicants to file five divisional applications in order to cover these other claims. If a search of the primer sequences in elected claim 34 prove to be free of the prior art and otherwise allowable, Applicants respectfully request that claims 33 and 35-38 be rejoined, and that examination be expanded to the other non-elected claims.

In as much as it is not clear from the restriction requirement (i.e., because some paragraphs on page 3 read on election of species), Applicants clarify for the record that it is the Office's position that claims 33-38 are patentably distinct inventions each from the other that could be claimed in separate divisional applications not subject to rejection for obviousness-type double patenting.

This Reply is fully responsive to the Office Action dated July 2, 2002. Therefore, further examination on the merits is respectfully requested.

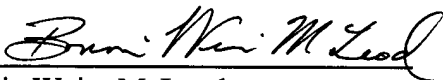
Except for issue fees payable under 37 CFR §1.18, the commissioner is hereby authorized by this paper to charge any additional fees during the pendency of this application including fees due under 37 CFR §1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 CFR §1.136(a)(3).

If the Examiner has any further questions relating to this Reply or to the application in general, she is respectfully requested to contact the undersigned by telephone so that allowance of the present application may be expedited.

Dated: October 2, 2002

Respectfully submitted
Morgan, Lewis & Bockius LLP

Morgan, Lewis & Bockius LLP
Customer No. 09629
1800 M Street, N.W.
Washington, D.C. 20036
202-739-3000
202-739-3001

By: 
Bonnie Weiss McLeod
Registration No. 43,255